

REMARKS

I. Summary of Office Action

Claims 1-7 and 9 were pending in the above-identified patent application.

A substitute specification without the claims has been requested pursuant to 37 C.F.R. § 1.125(a) “because the numbers and the natures of the amendments render it difficult to consider the application or to arrange the papers for printing or copying.” (Office Action, pp. 3-4).

Claims 1-7 and 9 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. (Office Action, pp. 4-6). Claims 1-7 and 9 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. (Office Action, pp. 6-7).

Claims 1-6 and 9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,822,157 to Stout (“Stout”) in view of U.S. Patent No. 1,768,354 to Falge (“Falge”). (Office Action, pp. 7-10). Claim 7 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Stout in view of Falge with or without U.S. Patent No. 3,199,114 to Malifaud (“Malifaud”). (Office Action, pp. 10-11).

II. Summary of Applicant’s Reply

As requested in the Office Action, a substitute specification is being filed concurrently herewith. Pursuant to 37 C.F.R. § 1.125(b), the substitute specification filed herewith includes no new matter. A marked-up version of the substitute specification is provided, showing all the

changes relative to the immediately prior version of the specification of record. A clean version of the substitute specification is also provided.

Claims 1 and 8 have been amended to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention. New independent claim 10 and dependent claims 11-15 have also been added. New claims 10-15 contain no new matter and are fully supported by the specification as originally filed.

The claim rejections are respectfully traversed.

III. The Section 112, First Paragraph Rejections

Claims 1-7 and 9 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. (Office Action, pp. 4-6).

With regard to claim 1, the Office Action asserts that “the disclosure as originally filed does not provide support for the features thereof ‘said mirror surface being sized such that the entirety of the outer mirror [sic] is utilized to provide . . . said school bus’ as recited on lines 4-8.” (Office Action, p. 4). This is not the case, and it is respectfully submitted that this feature is fully supported by the specification as originally filed. For example, as illustrated in Figs. 2A-2C of the drawings, various embodiments of mirror elements are shown, all of which have mirror surfaces “sized such that the entirety of the outer surface is utilized to provide a single, integrated wide angle field of view of a predetermined scene” as claimed. Furthermore, the specification as originally filed also fully supports that the view “extends both in a horizontal direction and in a vertical direction along a front and at least one side of a school bus” as claimed. For example, as described on page 3 of the specification, a mirror element can have

one field of view in the horizontal direction and a different angle of view in the vertical direction. (Specification, p. 3, ll. 12-15).¹

With regard to claim 1, the Office Action also alleges that “the disclosure as originally filed does not provide support for the feature thereof ‘being mounted and structured to fixedly maintain said single integrated wide angle field of view . . . said school bus’ as recited on lines 11-13.” (Office Action, p. 5). Again, this is not the case, and it is respectfully submitted that this feature is fully supported by the specification as originally filed. For example, as illustrated in Fig. 1 of the drawings, mirror element 10 is affixed to school bus 18. (See Specification, p. 3, ll. 6-8). The Office Action seems to assert that because the specification “discloses a mounting of a mirror to a school bus of the prior art” (Office Action, p. 5), this somehow cannot provide support for the claim language in question. Applicant respectfully disagrees. The specification clearly supports the mounting of a mirror element to a school bus, and such disclosure satisfies the requirements of 35 U.S.C. § 112, first paragraph.

With regard to claim 1, the Office Action also alleges that “the disclosure as originally filed does not provide support for the feature thereof ‘being treated with and comprising an antiglare material which is effective to reduce glare’ as recited on lines 24-25.” (Office Action, p. 5). The Office Action goes on to say that “the information has never disclosed that the so-called ‘antiglare material’ is effective to reduce glare.” (Office Action, p. 5, emphasis in original). It is respectfully submitted that the specification fully supports this feature. For example, the specification discloses that “[t]he sun rays reflection problem is solved by treating a portion, specifically the upper portion of the mirror surface with an anti-glare material, in any of the manners well known in the art . . .” (Specification, p. 3, l. 21 – p. 4, l. 1). The specification

¹ All citations to the specification in this response are to the clean copy of the substitute specification filed concurrently herewith.

goes on to describe the treatment of the outer surface of the mirror element. (See Specification, p. 4, ll. 2-15). This portion of the specification, among others, makes it clear that the anti-glare material solves the sun rays reflection problem. It follows that the anti-glare material is therefore “effective to reduce glare” as claimed.²

With regard to claim 1, the Office Action also alleges that “the disclosure as originally filed does not provide support for the features thereof “whereby the entirety of the mirror surface is utilized and the mirror surface . . . and whereby a mirror element of a smaller size is realizable.” (Office Action, p. 5). It is respectfully submitted that this feature is fully supported by the disclosure as originally filed. However, to facilitate prosecution, claim 1 has been amended to remove the reference to “whereby a mirror element of a smaller size is realizable.” Accordingly, the rejection of claim 1 with regard to this feature is moot and should be withdrawn.

With regard to claim 9, the Office Action states that the claim is rejected under 35 U.S.C. § 112, first paragraph, for similar reasons as claim 1. (Office Action, p. 6). Accordingly, the statements made hereinabove are applicable to claim 9, as well as the corresponding amendment to claim 9 to remove similar language.

For at least the reasons set forth above, claims 1 and 9 are in compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, and therefore the rejections of claims 1 and 9 should be withdrawn. It follows that dependent claims 2-7, which depend directly or indirectly upon independent claim 1, are also in compliance with the written description requirement, and therefore the rejection of those claims 35 U.S.C. § 112, first paragraph should also be withdrawn.

² See, e.g., Webster’s Ninth New Collegiate Dictionary, 1988, p. 397, for a definition of the term “effective”: “1a: producing a decided, decisive, or desired effect” (copy enclosed).

IV. The Section 112, Second Paragraph Rejections

Claims 1-7 and 9 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. (Office Action, pp. 6-7).

With regard to claim 1, the Office Action alleges that “each of the features thereof ‘the vehicle’ (line 19) and ‘the non-treated surface’ (line 28) lacks a proper antecedent basis.” (Office Action, p. 6). Claim 1 has been amended to recite “school bus” in place of the reference to “vehicle.” Claim 1 has also been amended to recite “the outer surface of the mirror element thereby comprising the treated surface and a non-treated surface,” such that the reference to “the non-treated surface” in the claim has proper antecedent basis. Accordingly, the rejection of claim 1 as lacking antecedent basis for these terms should be withdrawn.

With regard to claim 1, the Office Action also alleges that “it is unclear about the arrangement of the outer surface of the mirror element with respect to the vehicle (or the school bus) and the driver of the vehicle (or school bus) as recited in the features thereof ‘the contoured outer surface . . . of a driver’ (lines 10-11) and ‘the outer mirror . . . facing toward the vehicle to which the mirror element is mounted’ (lines 17-20).” (Office Action, p. 6). Claim 1 has been amended to recite “the outer mirror surface . . . facing toward the driver of the school bus to which the mirror is mounted,” thereby making clear the arrangement of the outer surface of the mirror element with respect to the school bus and driver. Accordingly, the rejection of claim 1 as lacking clarity in this respect should be withdrawn.

With regard to claim 1, the Office Action also alleges that “the feature thereof ‘said scene including images of both said front and said at least one side of said school bus’ (lines 7-8) is indefinite because it is unclear what component(s)/system(s) is/are used to form images of both said front and said at least one side of said school bus onto the scene to be viewed by the driver

of the school bus.” (Office Action, pp. 6-7). This is not the case, and it is submitted that one of ordinary skill in the art would fully understand how a “scene including images of both said front and said at least one side of said school bus” is formed by the outer surface of the claimed mirror element. In particular, one of ordinary skill in the art would understand that the positioning of the outer surface of the mirror element with respect to the school bus, as claimed, as well as the configuration of the outer surface of the mirror element -- “a convex, generally dome shaped and contiguous mirror surface” -- allow for the claimed “scene” to be formed by the outer surface. Accordingly, this claim feature satisfies the definiteness requirement of 35 U.S.C. § 112, second paragraph, and therefore the rejection of claim 1 on this ground should be withdrawn.

With regard to claim 9, the Office Action states that the claim is rejected under 35 U.S.C. § 112, second paragraph, for similar reasons as claim 1. (Office Action, p. 7). Accordingly, the statements made hereinabove are also applicable to claim 9, as well as the corresponding amendments to claim 9. Claim 9 therefore satisfies the definiteness requirement of 35 U.S.C. § 112, second paragraph, and the rejection of claim 9 should be withdrawn.

In addition, it follows that dependent claims 2-7, which depend directly or indirectly upon independent claim 1, are also definite, and therefore the rejection of those claims 35 U.S.C. § 112, second paragraph should also be withdrawn.

V. The Section 103 Rejections

Independent claims 1 and 9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Stout in view of Falge. (Office Action, pp. 7-10).

The Office Action cites to Stout as allegedly “meet[ing] all the limitations of the device as claimed except a portion of the mirror element being treated for reducing glare.” (Office Action, p. 8). The Office Action cites to Falge for this feature, and alleges that the combination

would have been obvious “for the purpose of providing a mirror assembly with a portion of its upper section having the function of reducing glare.” (Office Action, pp. 9-10). This simply is not the case, and it is submitted that the combination of Stout with Falge not only fails to teach or suggest all the features of independent claims 1 and 9, but that the combination would also not have been obvious to one of ordinary skill in the art at the time of Applicant’s invention.

First, the **combination of Stout with Falge fails to teach or suggest** the combination of features recited in independent claims 1 and 9, including “a portion of the outer surface . . . being treated with and comprising an antiglare material which is effective to reduce glare.” The Office Action cites to Falge as allegedly disclosing this feature: “[i]n particular, Falge discloses a mirror system having a mirror surface wherein the upper portion of the mirror is treated to reduce glare without rendering the treated portion opaque as to be non-reflective. See Falge, pages 1-2 and figs 1 and 8, for example.” (Office Action, p. 8). In contrast to claims 1 and 9, however, **Falge neither teaches nor suggests that an outer surface of a mirror is “treated with and compris[es] an antiglare material” as claimed.** Rather, the cited portions of Falge, as well as the remainder of the reference, merely disclose that the mirror is either **treated on its back surface** (Figs. 1 and 8) or has an additional screen or filter that is **flipped down** over the mirror (Figs. 5-7). **None of these embodiments teach or suggest the outer surface of the mirror being treated with and comprising an antiglare material.** Accordingly, the combination of Stout with Falge fails to teach or suggest the combination of features recited in claims 1 and 9, and for at least this reason, the rejections should be withdrawn.

Additionally, one of ordinary skill in the art at the time of Applicant’s invention would not have combined the teachings of Stout with those of Falge. In particular, Stout discloses a cross view mirror for mounting **outside of the bus**, whereas Falge discloses a rear view mirror

for mounting **within a vehicle**, and which is structured such that only a **portion of the outer reflecting surface** is used at any one time, depending on the tilt of the mirror. **In other words, the entire surface of the mirror is never used to provide a single, integrated, wide-angle field of view as with the claimed mirror assembly.** Thus, one of ordinary skill in the art, when faced with the teachings of Stout, simply would not have looked to a disclosure such as Falge for combination. (*See also* Aug. 21, 2007 Amendment/Submission, p. 7). **In addition, there is no reason to combine a cross view mirror with a rear view mirror, except using Applicant's own specification.**

The Office Action seems to assert that this argument is somehow related to the failure of Falge to teach every element of the claims, and therefore is misplaced since Stout allegedly discloses a mirror providing a single, integrated, wide-angle field of view. (Office Action, p. 12). This is incorrect, and it is submitted that **this argument relates to why one of ordinary skill in the art would not have combined the references.**

In addition to the above, the Office Action has also failed to show that the problem of glare when using a cross view mirror was even recognized in the art. It is submitted that **Applicant discovered this problem, and invented the claimed approaches for resolving it.** This further supports that the claims are patentable over the cited combination of Stout and Falge, or any other combination of references that may disclose a wide-angle mirror and a mirror configured to reduce glare.

Accordingly, for at least these reasons, claims 1 and 9 are patentable over the combination of Stout with Falge, and the therefore rejection of the claims under section 103 should be withdrawn. In addition, dependent claims 2-7 are allowable at least because

independent claim 1 is allowable. Thus, the rejections of dependent claims 2-7 are moot and should also be withdrawn.

VI. New Claims 10-15

New independent claim 10 is directed to “[a] cross-view, school bus or vehicle mirror assembly, comprising: a mirror pole; a mirror mount for connecting said mirror pole to at least one of a front fender and a front location of a school bus or vehicle; a mirror element affixed to said mirror pole and having a contoured outer mirror surface comprising a convex, generally dome shaped mirror surface” The mirror assembly further includes “an antiglare material disposed and treated on a three-dimensional upper area above a bottom half of said countered mirror surface.” New dependent claims 11-15 are directed to additional features of the mirror assembly, including the positioning of the antiglare material with respect to the mirror surface.

New claims 10-15 are fully supported by the specification as originally filed and add no new matter. Support for the new claims is found *inter alia*, throughout the specification, for example, at the following locations. With regard to the mounting of the mirror assembly, *see, e.g.*, Figure 1 of the drawings; page 3, lines 6-8 of the specification. With regard to the configuration of the mirror element, *see, e.g.*, Figures 2A-2C of the drawings; page 3, lines 12-15 of the specification. With regard to the antiglare material, *see, e.g.*, Figures 2A-4 of the drawings; page 3, line 21 to page 4, line 1 and page 4, lines 2-15 of the specification.

It is respectfully submitted that new independent claim 10 is patentable over the cited art, for similar reasons to those provided above with respect to independent claims 1 and 9. The combination of features in claim 10, including the “antiglare material disposed and treated on a three-dimensional upper area,” are neither taught nor suggested by the cited art. It follows that new dependent claims 11-15 are also patentable over the cited art.

VII. Conclusion

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, to the extent Applicant has discussed specific elements of the claims, Applicant has merely provided examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims as interpreted in view of the specification. Moreover, Applicant reserves the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

Any claims that have been cancelled are hereby cancelled without prejudice or disclaimer, and Applicant reserves the right to further prosecute these claims in continuing applications. In addition, Applicant has attempted to claim all embodiments disclosed in the

present application, and no disclaimer of any embodiments is hereby intended by the presently pending claims.

Any narrowing amendments made to the claims, if any, in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicant hereby retracts any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicant specifically retracts statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

Applicant also traverses any "Official Notice," "Design Choice," "Admitted Prior Art" or other alleged prior art that the Examiner purports are well known with respect to the claimed combination of the present invention. Applicant disagrees and requests the Examiner to provide a prior art reference describing any of these features that the Examiner has not provided a prior art reference or an affidavit under 37 C.F.R. § 1.104(d)(2) providing details of why it would have

been obvious. In the absence of either, Applicant requests withdrawal of this rejection for these reasons as well.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

VIII. Authorization

The Director is hereby authorized to charge any additional fees which may be required for this Reply, or credit any overpayment, to Deposit Account No. 08-0219.

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Director is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,
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